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In re Application of KOSAN et al :
U.S. Application No.: 10/533,518 :
PCT Application No.: PCT/DE2003/003338 : DECISION
Int. Filing Date: 09 October 2003 :
Priority Date Claimed: 01 November 2002 :
Attorney Docket No.: HO-P03170US0 :
For: ELECTRICAL PRESSING DEVICE :

This is in response to applicant's "Petition Under 37 CFR 1.182" filed 26 January 2007 and the accompanying "Response to Notification of Missing Requirements Under 35 U.S.C. 371 in the United States Designated/Elected Office", which is being treated as a petition under 37 CFR 1.47(a).

BACKGROUND

On 09 October 2003, applicant filed international application PCT/DE2003/003338, which claimed priority of an earlier Germany application filed 01 November 2002. A copy of the international application was communicated to the USPTO from the International Bureau on 13 May 2004. The thirty-month period for paying the basic national fee in the United States expired on 01 May 2005.

On 28 April 2005, applicant filed national stage papers in the United States Designated/Elected Office (DO/EO/US). The submission was accompanied by, *inter alia*, the basic national fee required by 35 U.S.C. 371(c)(1).

On 15 March 2006, the DO/EO/US mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905), which indicated that an oath or declaration in compliance with 37 CFR 1.497 must be filed.

On 24 March 2006, applicant purportedly filed a petition under 37 CFR 1.47(a) along with an executed declaration.

On 26 January 2007, applicant filed the present petition under 37 CFR 1.181.

DISCUSSION

I. Petition Under 37 CFR 1.181

The evidence of record is sufficient to establish that the petition under 37 CFR 1.47(a) and declaration was originally filed on 24 March 2006. Specifically, the copy of the return postcard, which includes the petition under 37 CFR 1.47(a) and declaration in its itemized contents and which bears a USPTO date stamp of 24 March 2006, serves as *prima facie* evidence that the petition under 37 CFR 1.47(a) and declaration was received by the USPTO on 24 March 2006.

II. Petition Under 37 CFR 1.47(a)

A petition under 37 CFR 1.47(a) must be accompanied by: (1) an oath or declaration by each applicant on his or her own behalf and on behalf of the nonsigning joint inventors, (2) factual proof that the missing joint inventors refuse to join in the application or cannot be reached after diligent effort, (3) the fee set forth in §1.17(i), and (4) the last known addresses of the nonsigning joint inventors.

With regard to item (1) above, applicant has submitted a declaration signed by the available inventor on his own behalf and on behalf of the nonsigning inventor.

With regard to item (2) above, MPEP 409.03(d) states in relevant part,

Where a refusal to sign the application papers is alleged, the circumstances of this refusal must be specified in an affidavit or declaration by the person to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

Before a refusal can be alleged, it must be demonstrated that a bona fide attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature. A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney.

When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the affidavit or declaration. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the affidavit or declaration.

When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in the affidavit or declaration. If there is documentary evidence to support facts alleged in the affidavit or declaration, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the affidavit or declaration.

The petition states that joint inventor Kai Seelig refuses to sign the application papers. Although petitioner has provided an affidavit signed by the person with firsthand knowledge of

efforts of obtain Seelig's signature, proper supporting documentary evidence has not been furnished. In particular, English language translations of the letter mailed to Seelig and the returned envelope have not been provided. The reason that the letter was not delivered (which may become clear after a translation is provided) has not been shown, and it has not been established that Seelig is the person who refused the mailing. For example, the letter could have been refused by the current occupant if Seelig no longer resides at the mailing address. The translation may discount such a possibility. Additionally, although the affidavit of Matthias Philipp states that Mr. Philipp attempted to telephone Seelig numerous times, more details regarding such telephone conversations must be provided. For instance, it should be indicated whether Mr. Philipp actually spoke to Seelig, which may establish that Seelig resides at the last known address of record, and the details of any conversations should be stated.

With regard to item (3) above, the requisite petition fee will be charged to Deposit Account No. 06-2375 as authorized in the petition.

With regard to item (4) above, the petition states the last known address of the nonsigning inventor.

CONCLUSION

For the reasons set forth in §I above, the petition under 37 CFR 1.181 is GRANTED.

For the reasons set forth in §II above, the petition under 37 CFR 1.47(a) is DISMISSED without prejudice.

If reconsideration on the merits of the petition under 37 CFR 1.47(a) is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Extensions of time are available under 37 CFR 1.136(a). Failure to timely file a proper response will result in abandonment of the application. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)". No additional petition fee is required.

Please direct further correspondence with respect to this matter to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

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